

ESTTA Tracking number: **ESTTA175523**Filing date: **11/19/2007**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91180111
Party	Defendant SHAFIQ, MUHAMMAD
Correspondence Address	CHRISTOPHER J. DAY LAW OFFICE OF CHRISTOPHER DAY 301 E BETHANY HOME ROAD, SUITE A-213 PHOENIX, AZ 85012  chris@daylawfirm.com
Submission	Answer and Counterclaim
Filer's Name	Christopher J. Day
Filer's e-mail	chris@daylawfirm.com
Signature	/Christopher J. Day/
Date	11/19/2007
Attachments	SCHIESSER ANSWER_1911200711470500.pdf ( 25 pages )(712239 bytes )

## Registrations Subject to Cancellation

Registration No	1474247	Registration date	01/26/1988
Registrant	SCHIESSER AG POSTFACH 1520, 7760 RADOLFZELL AM BODENSEE, GERMANY		
Goods/Services Subject to Cancellation	Class 025. First Use: 1983/08/13 , First Use In Commerce: 1983/08/13 Goods/Services:		
Grounds for Cancellation	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		
Registration No	806403	Registration date	03/29/1966
Registrant	SCHIESSER AKTIENGESELLSCHAFT POSTFACH 1520 SCHUTZENSTRASSE 18 RADOLFZELL/BADEN-WURTTENBERG, GERMANY		
Goods/Services Subject to Cancellation	Class U039 (International Class 010, 025, 026). First Use: 1958/03/20 , First Use In Commerce: 1959/04/20 Goods/Services:		
Grounds for Cancellation	The registered mark has been abandoned.		
	The registration was obtained fraudulently.		

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 78857218  
Published in the Official Gazette on June 19, 2007

*With Counterclaims for:*

Cancellation of Registration No. 1474247  
*and*  
Cancellation of Registration No. 0806403

SCHIESSER AG,

Opposer,

v.

MUHAMMAD SHAFIQ,

Applicant.

Opposition No. 91180111

**APPLICANT'S ANSWER AND COUNTERCLAIMS  
INCLUDING COUNTERCLAIMS FOR  
CANCELLATION OF REG. NO. 1474247 AND  
CANCELLATION OF REG. NO. 0806403**

**ANSWER**

COMES NOW, Applicant, Muhammad Shafiq, and files this Answer to the Notice of  
Opposition filed with respect to the above referenced matter and answers as follows:

1. Applicant is without knowledge or information sufficient to form a belief; therefore denied.
2. Admitted.
3. Admitted.
4. Applicant admits that Opposer owns Application Serial No. 79/028,444, Applicant admits that the claimed Section 67 priority date of Application Serial No. 79/028,444 is October 22, 2004, and Applicant admits that the goods Opposer has identified in Application Serial No. 79/028,444 include the approximately 160 separate goods identified in paragraph 4 of the Notice of Opposition. Applicant denies all remaining allegations contained in paragraph 4.
5. Applicant is without knowledge or information sufficient to form a belief; therefore denied.
6. Applicant admits that Applicant is not named "Schiesser" and admits that Applicant does not employ anyone named "Schiesser." Applicant denies all remaining allegations contained in paragraph 6.
7. Applicant reincorporates its responses to paragraphs 1-6.

8. Denied.
9. Denied.
10. The Notice of Opposition does not contain a paragraph 10.
11. The Notice of Opposition does not contain a paragraph 11.
12. The Notice of Opposition does not contain a paragraph 12.
13. Applicant reincorporates its responses to paragraphs 1-6.
14. Denied.
15. Denied.

#### DEFENSES

16. Opposer lacks standing to oppose registration of Applicant's mark, because Opposer's claim of likelihood of confusion is wholly without merit.
17. Applicant's mark, when viewed in its entirety and in light of Applicant's goods, does not create a likelihood of confusion with any mark identified by Opposer.

18. Applicant asserts that the mark in the pleaded pending application cited by Opposer, namely U.S. App. Ser. No. 79028444 is primarily merely a surname not registrable on the Principal Register under Section 2(e)(4), and therefore not registrable in the United States.
19. As more fully set forth in its counterclaims, Applicant asserts that Opposer's prior registrations, including the registration on which Opposer based a 2(f) claim in connection with its application to register U.S. App. Ser. No. 79028444, are subject to cancellation under Medinol Ltd. v. Neuro Vasx, Inc., 67 U.S.P.Q.2d 1205, 1209 (TTAB 2003) and related cases.
20. Unclean hands.

WHEREFORE, Applicant respectfully requests that Opposer's opposition be denied, and that registration of Applicant's mark be granted.

### **COUNTERCLAIMS**

#### **COUNTERCLAIM NO. 1 FOR CANCELLATION OF REG. NO. 1474247**

1. Upon information and belief, Opposer is the owner of U.S. Reg. No. 1474247 for the mark SCHIESSER (and design) (the "247 Registration").

2. Although Opposer did not specifically plead the '247 Registration, the Notice of Opposition did allege that Opposer has used the mark "SCHIESSER" in connection with a wide variety of clothing items and alleged that Applicant's created a likelihood of confusion with Opposer's SCHIESSER mark previously used in the United States.
3. Applicant intends to use Applicant's SCHIESSER and design mark in commerce in the United States in connection with mobile phones, power supply instruments, namely, electrical power extension cords; and power controls, namely, power access ports for use with electrical control panels for connecting multiple data and electrical devices; flashlights, electric hair dryers and electric action toys.
4. Applicant's legitimate and lawful use of the mark in App. Ser. No. 78857218 will be jeopardized by continued registration of the mark in the '403 Registration.
5. Applicant believes that it is or will be damaged by continued registration of the mark in the '247 Registration and hereby petitions to cancel same.

*Opposer Has Abandoned or Partially Abandoned the Mark*

6. Upon information and belief, Opposer has not used the mark identified in the '247 Registration for some or all of the goods identified in the '247 Registration for more than three years.

7. Upon information and belief, Opposer has discontinued use of the mark identified in the '247 Registration for some or all of the goods identified in the '247 Registration and has no intent to resume such use.

*The Fraudulent Application*

8. Upon information and belief, the '247 Registration was obtained through fraud and subject to cancellation under the Board's holding in Medinol Ltd. v. Neuro Vasx, Inc., 67 U.S.P.Q.2d 1205, 1209 (TTAB 2003) and related cases.
9. The '247 Registration issued from App. Ser. No. 73640293, filed on a Section 1(a) basis on January 20, 1987.
10. The goods listed in App. Ser. No. 73640293 were outerwear, namely jackets, coats and wind resistant jackets; underwear; sleepwear; beachwear, namely swimsuits, bikinis, bathing shorts and beach robes; leisurewear, namely suits, cardigans, pullovers, shirts, shorts, slacks, trousers, skirts and dresses; stockings; socks; foundation garments; neckties; suspenders; hats; shoes, boots and slippers.
11. App. Ser. No. 73640293 contained a statement that the mark was in use for the above identified goods on the date the application was filed.

12. App. Ser. No. 73640293 contained a declaration alleging the truth of the statements contained in the application, however the initial declaration was unsigned.
13. App. Ser. No. 73640293 was unsigned when filed. In response to a requirement issued by the Examining Attorney, Opposer subsequently filed a declaration, purportedly dated January 13, 1987, signed by Gunter Schonepauck (the “Schonepauck Declaration”).
14. The Schonepauck Declaration alleged the truth of the statements contained in the application.
15. Upon information and belief, as of the application filing date of January 20, 1987, Opposer was not selling in commerce in the United States all of the goods identified in App. Ser. No. 73640293.
16. Upon information and belief, as of January 13, 1987, the date the Schonepauck Declaration was purportedly signed, and as of July 20, 1987, the date the Schonepauck Declaration was submitted to the USPTO, Opposer was not selling in commerce in the United States all of the goods identified in App. Ser. No. 73640293.
17. Upon information and belief, the above identified statements, namely that the mark was in use for the identified goods on the date the application was filed, and that the statements in the application were true, were in fact false.



18. Upon information and belief, Opposer knew or should have known that the statements that the mark was in use for all of the identified goods was false or misleading.
19. Upon information and belief, Opposer's statement that the mark was in use for all of the goods and services as identified in the application constituted a knowingly false representation of material fact.
20. Upon information and belief, but for the false statement in the application and accompanying false declaration, the United States Patent and Trademark Office would not have issued the '247 Registration.

*The Fraudulent Section 8 & 15*

21. On or about October 19, 1993, Opposer filed a combined Declaration under Sections 8 and 15 with respect to the '247 Registration (the "Combined 8 and 15").
22. The Combined 8 and 15 contained a declaration that the mark identified in the '247 Registration had been in continuous use in commerce between the United States and Germany for each of the goods identified in the '247 Registration and that the mark was still in use.
23. Upon information and belief, the above identified statements, namely that the mark had been in continuous use in commerce between the United States and Germany for each of

the goods identified in the '247 Registration, and that the mark was still in such use, was in fact false.

24. Upon information and belief, Opposer knew or should have known that the above identified statements in the Combined 8 and 15 were false or misleading.
25. Upon information and belief, Opposer's statement in the Combined 8 and 15 constituted a knowingly false representation of material fact.
26. Upon information and belief, but for the false statement in the Combined 8 and 15, the United States Patent and Trademark Office would have cancelled the '247 Registration.

#### **RELIEF REQUESTED**

Applicant requests the Board cancel the '247 Registration, and Applicant requests such other and further relief as the Board deems just and proper.

#### **COUNTERCLAIM NO. 2 FOR CANCELLATION OF REG. NO. 0806403**

27. Applicant repeats and realleges the allegations in paragraphs 1-26 as if fully set forth herein.

28. Upon information and belief, Opposer is the owner of U.S. Reg. No. 0806403 for the mark SCHIESSER (and design) (the “‘403 Registration”).
29. Although Opposer did not specifically plead the ‘403 Registration, the Notice of Opposition did allege that Opposer has used the mark “SCHIESSER” in connection with a wide variety of clothing items and alleged that Applicant’s created a likelihood of confusion with Opposer’s SCHIESSER mark previously used in the United States.
30. Applicant’s legitimate and lawful use of the mark in App. Ser. No. 78857218 will be jeopardized by continued registration of the mark in the ‘403 Registration.
31. Applicant believes that it is or will be damaged by continued registration of the mark in the ‘403 Registration and hereby petitions to cancel same.

*Opposer Has Abandoned or Partially Abandoned the Mark*

32. Upon information and belief, Opposer has not used the mark identified in the ‘403 Registration for some or all of the goods identified in the ‘403 Registration for more than three years.

33. Upon information and belief, Opposer has discontinued use of the mark identified in the ‘403 Registration for some or all of the goods identified in the ‘403 Registration and has no intent to resume such use.

*The Fraudulent Application*

34. Upon information and belief, the ‘403 Registration was obtained through fraud and subject to cancellation under the Board’s holding in Medinol Ltd. v. Neuro Vasx, Inc., 67 U.S.P.Q.2d 1,205, 1209 (TTAB 2003) and related cases.
35. The ‘403 Registration issued from App. Ser. No. 72210620, filed on a Section 1(a) basis on January 25, 1965.
36. Upon information and belief, the goods listed in App. Ser. No. 72210620 were stockings and socks, woven and knitted clothing-namely, dresses, suits, skirts, blouses, shirts, and coats underwear for men, women and children of cotton, linen, silk, wool, and synthetic materials, foundation garments, neckties, suspenders, and gloves.
37. Upon information and belief, App. Ser. No. 72210620 contained a statement that the mark was in use for the above identified goods on the date the application was filed.
38. Upon information and belief, App. Ser. No. 72210620 contained a declaration alleging the truth of the statements contained in the application (“the ‘620 Declaration”).

39. Upon information and belief, as of the application filing date of January 25, 1965, Opposer was not selling in commerce in the United States all of the goods identified in App. Ser. No. 72210620.
40. The above identified statements, namely that the mark was in use for the identified goods on the date the application was filed, and that the statements in the application were true, were in fact false.
41. Upon information and belief, Opposer knew or should have known that the statements that the mark was in use for all of the identified goods was false or misleading.
42. Upon information and belief, Opposer's statement that the mark was in use for all of the goods and services as identified in the application constituted a knowingly false representation of material fact.
43. Upon information and belief, but for the false statement in the application and accompanying false declaration, the United States Patent and Trademark Office would not have issued the '403 Registration.

*The Fraudulent 1986 Section 8 and 9*

44. The '403 Registration was initially registered for a period of 20 years and was required to be renewed in 1986.

45. Upon information and belief in or about 1986, Opposer filed a Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9 with respect to the '403 Registration (the "1986 8 & 9").
46. Upon information and belief, the 1986 8 & 9 contained a statement that the mark was in use in commerce in connection with all the goods identified in the registration.
47. Upon information and belief, as of the date of the 1986 8 & 9, Opposer did not use in commerce the mark identified in the '406 Registration with each of the goods identified in the '406 Registration.
48. Upon information and belief, Opposer knew or should have known that the statements that the mark was in use for all of the identified goods was false or misleading.
49. Upon information and belief, Opposer's statement that the mark was in use for all of the goods and services as identified in the registration constituted a knowingly false representation of material fact.
50. Upon information and belief, but for the false statement in the 1986 8 & 9 and accompanying false declaration, the United States Patent and Trademark Office would not have renewed the '403 Registration in 1986.

*The Fraudulent Section 8 and 9*

51. On or about January 6, 2006, Opposer filed a Combined Declaration of Use In Commerce & Application For Renewal of Registration of A Mark Under Sections 8 & 9 with respect to the '403 Registration (the "Combined 8 & 9").
52. The Combined 8 & 9 contained a statement that the mark was in use in commerce in connection with all the goods identified in the registration except "stockings, dresses, shirts, coats, neckties, suspenders."
53. The deletion of stockings, dresses, shirts, coats, neckties and suspenders from the '403 Registration resulted in the following goods remaining in the registration: socks, woven and knitted clothing-namely, suits, skirts, blouses, underwear for men, women and children of cotton, linen, silk, wool, and synthetic materials, foundation garments, and gloves.
54. Upon information and belief, as of January 6, 2006, Opposer did not use in commerce the mark identified in the '406 Registration with each of the goods identified in the '406 Registration as amended by the Combined 8 & 9.
55. Upon information and belief, Opposer knew or should have known that the statements that the mark was in use for all of the identified goods was false or misleading.

56. Upon information and belief, Opposer's statement that the mark was in use for all of the goods and services as identified in the registration constituted a knowingly false representation of material fact.
57. Upon information and belief, but for the false statement in the Combined 8 & 9 and accompanying false declaration, the United States Patent and Trademark Office would not have renewed the '403 Registration.

#### RELIEF REQUESTED

Applicant requests the Board cancel the '403 Registration, and Applicant requests such other and further relief as the Board deems just and proper.

#### **NOTICE OF SEPARATELY FILED NOTICE OF OPPOSITION TO REGISTRATION OF OPPOSER'S PLEADED APPLICATION**

58. The mark in the pleaded pending application cited by Opposer, namely U.S. App. Ser. No. 79028444 (the '444 Application) is not entitled to registration, and Applicant has separately filed a Notice of Opposition with respect to the '444 Application.
59. Applicant believes that this proceeding and Applicant's separately filed opposition to registration of the '444 Application can most efficiently be resolved if the proceedings are consolidated, and Applicant hereby consents to consolidation of the proceedings.



60. As more fully set forth in the Notice of Opposition filed in connection with the ‘444 Application, the ‘444 Application is not entitled to registration for the reasons set forth below.
61. The sole statutory filing basis for the ‘444 Application was a request for extension of protection of an international registration to the United States, under §66(a) of the Act.
62. There is no provision in the Trademark Act for registration of a mark in a request for an extension of protection on the Supplemental Register. If the proposed mark is not registrable on the Principal Register, the extension of protection must be refused.
63. The ‘444 Application was published for opposition on November 13, 2007.
64. The goods for which Applicant seeks to register Applicant’s mark are mobile phones; power supply instruments, namely, electrical power extension cords; and power controls, namely, power access ports for use with electrical control panels for connecting multiple data and electrical devices; flashlights; electric hair dryers; and electric action toys.
65. The goods for which Opposer seeks to register the mark in the ‘444 Application are incontinence underwear, incontinence pants, incontinence napkins; underwear for patients with skin diseases, underwear for patients suffering from an allergy, underwear for patients suffering from neurodermitis, all foregoing for medical purposes; underwear for

breastfeeding mothers, nursing bras, nursing vests; orthopedic products, namely, orthopedic trousers with pads for prevention and treatment of deformation and dysfunction of the musculoskeletal system, orthopedic braces and supports, orthopedic shoes, soles of shoes, insoles, shoe inserts and arch supports, arch supports, also in the form of blanks, surgical implants made of synthetic materials, orthopedic belts, medical compression stocking for orthopedic purposes, harnesses and bandage splints for orthopedic purposes; belts for medical purposes, orthopedic anatomical joint bandages, medical compression stockings, orthopedic knee bandages, girdles for medical purposes, trusses, clothing for operating rooms, namely, surgical scrub suits, surgical gowns; maternity support belts; clothing, namely, hats, gloves, mittens and scarves for women, men and children; custom-made-to-order underwear and fashionable underwear; outer clothing for women, men and children, namely, sweaters, hats and scarves all made of wool; suits, shirts, trousers, Bermuda shorts; frocks, blouses, jumpers, skirts; jackets, stuff jackets, waistcoats, coats, overalls, parkas, raincoats, wind jackets; hosiery, pullovers, sweaters, bandanas, jerseys, t-shirts, sweatshirts, terry clothing, namely, moisture or liquid absorbant and perspiration absorbant underwear; women's, men's and children's underwear, underwear, bras, women's underpants, breeches, women's vests, bustiers, corselets, bodices, teddies, bodysuits, lingerie; combinations of vests and slips; slips, petticoats, negligees; men's underpants, boxer shorts, men's vests; children's underpants, children's vests; women's, men's and children's sports underwear, sports bras, socks, stockings, mid-calf length socks, tights, sock suspenders, outer clothing for sports, namely, gloves, mittens, scarves, ski shell, namely, ski vests, ski hooded jackets, hiking

jackets, hiking hooded jackets, hooded sweatshirts, running jackets, wind vests, hiking pants, parkas insulated vests, hats for outdoor pursuits and sports; clothing for gymnastics, namely, gym shorts, gym suits, leotards, tights; jogging suits, leggings, cyclists' clothing, namely, cyclists' jerseys; knit wear, namely, knitted underwear; singlets; bathing suits, bathing trunks; swimwear for women, men and children, swim suits, swim trunks, bathrobes, beach clothes, namely, beach coverups; beach wear; nightwear for women, men and children, pyjamas, nightgowns, dressing gowns; layettes; infantwear; baby pyjamas, baby underwear; babies' napkin-pants, namely, infant diaper covers of textile; babies' diapers of textile; gloves of textile, wrist bands, sweatbands, headbands, belts, suspenders, neckties, scarves, shawls, ear protectors, namely, ear muffs; aprons; shoes. bath sandals, bath slippers, sandals, sport shoes, esparto shoes, beach shoes; head wear; bathing caps, shower caps, hats, hoods, caps.

66. In the present Opposition, Opposer has alleged that Applicant's mark, when used on or in connection with Applicant's goods, creates a likelihood of confusion with the mark in the '444 Application within the meaning of Section 2(d) of the Lanham Act.

*Fraudulent Declaration*

67. Section 66(a) of the Trademark Act requires that a request for extension of protection to the United States include a declaration that the Applicant has a bona fide intention to use the mark in commerce that can be controlled by the United States Congress.

68. Upon information and belief, the request for extension of protection that gave rise to the '444 Application contained a declaration stating that Opposer had a bona fide intention to use the mark in commerce that can be controlled by the United States Congress on or in connection with the goods/services identified in the international application.
69. Upon information and belief, on the date the '444 Application was filed or any date relevant hereto, Opposer did not have a bona fide intention to use the mark in commerce that can be controlled by the United States Congress on or in connection with the goods/services identified in the international application.
70. Upon information and belief, at any time relevant hereto, Opposer did not have a bona fide intention to use the mark in commerce that can be controlled by the United States Congress on or in connection with each and every good identified in the international application/'444 Application.
71. Opposer knew or should have known that the statement that it had a bona fide intention to use the mark in commerce that can be controlled by the United States Congress on or in connection with the goods/services identified in the international application was false or misleading.
72. Upon information and belief, Opposer's statement that it had a bona fide intention to use the mark in commerce that can be controlled by the United States Congress on or in

connection with the goods/services identified in the international application constituted a knowingly false representation of material fact.

73. Upon information and belief, but for the false statement that Opposer had a bona fide intention to use the mark in commerce that can be controlled by the United States Congress on or in connection with the goods/services identified in the international application, the International Bureau would not have forwarded the '444 Application to the United States Patent and Trademark Office, the United States Patent and Trademark Office would not have accepted the '444 Application, and the United States Patent and Trademark Office would not have approved the '444 Application for publication.

*Surname Refusal*

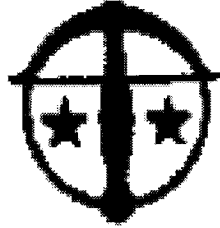
74. The mark in the '444 Application must be refused registration on the Principal Register because the mark SCHIESSER is primarily merely a surname. Trademark Act Section 2(e)(4), 15 U.S.C. §1052(e)(4); TMEP §1211.
75. "Schiesser" is a surname.
76. The primary significance of the SCHIESSER to the purchasing public is that of a surname.
77. SCHIESSER has the look and feel of a surname.

78. During prosecution of the '444 Application, the Examiner refused registration on the Principal Register under Section 2(e)(4), and included evidence from the Nexis ® database P-Finder, establishing the surname significance of the mark.
79. Opposer is the owner of U.S. Reg. No. 1474247 for the mark SCHIESSER (and design) (the “‘247 Registration”).
80. Applicant has separately petitioned to cancel the ‘247 Registration based on abandonment and based on fraud within the meaning of Medinol Ltd. v. Neuro Vaxx, Inc., 67 U.S.P.Q.2d 1205, 1209 (TTAB 2003) and related cases.
81. In response to the 2(e)(4) refusal, Opposer submitted a 2(f) claim based on the fraudulently obtained and fraudulently maintained ‘247 Registration.

*Deficient 2(f) Claim – Not the Same Mark*

82. Opposer does not own a prior registration on the Principal Register for a typed form mark SCHIESSER.

83. The mark in Opposer's claimed prior '247 Registration includes the stylized word "Schiesser" together with the following logo:



84. The mark in the '444 Application does not include the logo found in Opposer's claimed prior '247 Registration.
85. For purposes of a 2(f) claim, the mark in the '444 Application is not the same mark as the '247 Registration or any previously registered mark of Opposer.
86. For purposes of a 2(f) claim, the mark in the '444 Application is not the legal equivalent of the '247 Registration or any previously registered mark of Opposer.

*Deficient 2(f) Claim—Not the Same or Related Goods*

87. The goods in Opposer's claimed prior '247 Registration are "outerwear, namely jackets, coats and wind resistant jackets; underwear; sleepwear; beachwear, namely swimsuits, bikinis, bathing shorts and beach robes; leisurewear, namely suits, cardigans, pullovers,

shirts, shorts, slacks, trousers, skirts and dresses; stockings; socks; foundation garments; neckties; suspenders; hats; shoes, boots and slippers.”

88. The goods in the ‘444 Application include “harnesses and bandage splints for orthopedic purposes,” “orthopedic braces and supports,” “surgical implants made of synthetic materials,” and “incontinence napkins.”
89. For purposes of a 2(f) claim, the goods named in the ‘444 Application include numerous goods that are not sufficiently similar to the goods named in the prior ‘247 Registration.
90. For purposes of a 2(f) claim, Opposer does not own a prior registration on the Principal Register for goods sufficiently similar to the goods named in the ‘444 Application.

*Opposer’s Prior Marks Are Subject to Cancellation under Medinol*

91. Even if Opposer’s prior registration of the SCHIESSER logo mark in Class 25 did support a partial 2(f) claim for *some* of Opposer’s goods, Opposer’s two prior registrations are subject to cancellation as Applicant has alleged herein that both were obtained through fraud within the meaning of Medinol.
92. Opposer cannot base a 2(f) claim on a fraudulently obtained registration that is subject to cancellation in this same proceeding.



*Because Opposer's Mark is Primarily Merely a Surname, Registration Must be Refused*

93. There is no provision in the Trademark Act for registration of a mark in a request for an extension of protection on the Supplemental Register. If the proposed mark is not registrable on the Principal Register, the extension of protection must be refused.
94. The mark in the '444 Application is not registrable on the Principal Register, and, as set forth in Applicant's separate Notice of Opposition to registration of the mark in the '444 Application, registration of the mark in the '444 Application must be refused. TMEP 1904.02(c); 15 U.S.C. § 1141h(a)(4); 37 C.F.R. §§ 2.47(c) and 2.75(c).

CONCLUSION

Opposer's two prior SCHIESSER logo registrations were and are registered for a wide variety of clothing items that Opposer has *never* sold. After Medinol, it is clear that the '247 Registration and the '403 Registration are ripe for cancellation. Opposer's '444 Application is not entitled to registration because Opposer has no intent to use the mark for all of the identified goods, rendering the '444 Application fraudulent, and because the mark in the '444 Application is primarily merely a surname and (because the '444 Application is a 66(a) application) not registrable. Accordingly Applicant requests that the Board cancel the '247 Registration and the '403 Registration, and refuse to register the '444 Application. A Notice of Opposition to register the '444 Application is filed concurrently herewith.

Moreover, regardless of the status of Opposer's registrations, Applicant respectfully requests that the Board find that Applicant's mark, when used on or in connection with the goods identified in the application, does not create a likelihood of confusion within the meaning of Section 2(d) of the Lanham Act, deny Opposer's opposition, and allow Applicant's mark to proceed to registration.

Dated this 19<sup>th</sup> day of November, 2007.

/Christopher J. Day/

Christopher J. Day, Attorney for Applicant  
Law Office of Christopher Day  
301 East Bethany Home Road, Suite A-213  
Phoenix, AZ 85012  
Telephone: (602) 258-4440  
Facsimile: (602) 258-4441

#### **CERTIFICATE OF SERVICE**

I hereby certify that this document is being deposited on November 19<sup>th</sup>, 2007, in the U.S. mail, first class postage pre-paid, addressed to counsel for Opposer at the following Address:

Joan Kupersmith Larkin, Esq.  
Christopher C. Larkin, Esq.  
Seyfarth Shaw LLP  
2029 Century Park East, Suite 3300  
Los Angeles, CA 90067

/Christopher J. Day/

Christopher J. Day